



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/572,639

03/17/2006

Yoshitaka Tomigahara

2006_0369A

5260

513 7590 02/19/2009

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

02/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,639	Applicant(s) TOMIGAHARA ET AL.	
	Examiner Taofiq A. Solola	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-49, 51, 53, 54, 56, 58, 59, 61, 63, 65, 67, 69, 71 and 73 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1-3,5-49,51,53,54,56,58,59,61,63,65,67,69,71 and 73.

Art Unit: 1625

Claims 1-49, 51, 53-54, 56, 58-59, 61, 63, 65, 67, 69, 71, 73, are pending in this application.

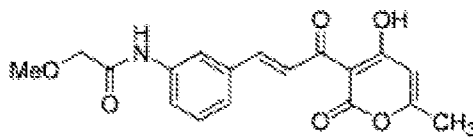
Claims 50, 52, 55, 57, 60, 62, 64, 66, 68, 70, 72, are canceled.

Only claim 4 is elected. Others are drawn to non-elected invention.

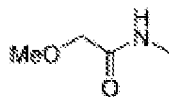
Response to Restriction

The election of group IV, claim 4, with traverse in the Paper filed 11/3/08 is hereby acknowledged. The traversal is on the basis that compounds of groups I-XIII, claims 1-25, were not restricted in the PCT application. This is not persuasive for reasons set forth in the last Office Action. Just because the International Search Authority chose not to invoke PCT Rules 13.1 and 13.2 is not a valid basis for the Office not to do so. Also, actions by the International Search Authority are not precedent or binding on this Office.

Applicant also selects this species



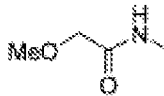
of claim 18,



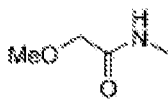
wherein X_a is . Therefore, claim 4 is being examined in accordance with applicant's election.

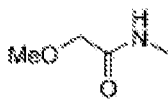
The restriction is deemed proper and therefore, made FINAL.

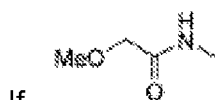
Status of Claims

The compounds of claim 18 wherein ring A is phenyl or pyridyl and only  as substituent have been searched and found novel. Therefore, all the substituents of formula IV, except X_a, within the scope of claim 4, would not be subject to further restriction. The following are now in condition for allowance over prior arts of record.

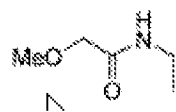
Art Unit: 1625



In formula IV, X α is limited to , ring A is phenyl or pyridyl, Ka, La, Qa and Ya are as defined in claim 4. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claim 4, are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.

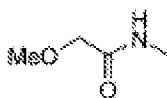


If  as representing X α is within the scope of formulae I-III, V-XIII, in claims

1-3, 5-25, and applicant restricts X α in the formulae and claims to , the restriction of groups I-III, V-XIII will be withdrawn.

Objection

Claim 4 is objected for containing non-elected inventions and would be in position for



allowance if X α is limited to .

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

Art Unit: 1625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

/Taofiq A. Solola/

Primary Examiner, Art Unit

February 13, 2009